

DI 25. (deleted) The method of claim 23 where two pairs of hands are dealt so that each hand has three interior cards and all hands share two common end cards.

REMARKS

Claim 22 to 24

In the Applicant's August 5, 2003 Amendment, Applicant had deleted claims 20 to 21, but meant to delete claim 22 as well. Three new claims were added in the August 5, 2003 Amendment, but inadvertently were started at number 22. That was an error. The new claims should have begun with number 23. An appropriate change has been made.

Claims 23 to 24 do not add new matter. Applicant respectfully submits claim 25 does not add new matter, but he has deleted the claim to advance prosecution.

Claim 23, a method claim, has the following claim elements:

“(a) dealing cards in a four sided diamond shape, consisting of 16 cards, where each side is a separate hand that has five cards consisting of three interior cards and two corner cards, the corner cards are shared with two adjacent hands, ~~and each side forms a separate payline,~~”

Although Applicant does not agree that the term “payline” is new matter, as discussed below, he has deleted it from the claims to advance prosecution. The remaining claim elements are shown in Figure 2 where 16 cards are dealt in a four sided diamond shape. Each side is a separate hand consisting of five cards with three interior cards and two corner cards shared by adjacent hands.

The specification, page two states:

“Figure 2 describes one embodiment where four hands A, B, C, and D are displayed. Hand A consists of cards 10 (jack), 20 (10), and 30 (queen) which are displayed.”

The corner cards are dealt face down as shown by “x”s in Figure 2, and are shared by adjacent hands.

The next claim element of claim 23 is:

“(b) permitting a player to exchange cards from one hand to another hand;”

Card exchange is shown in Figures 2, 3, 4, 5, 6 and 7. The exchange can be interior cards (Figures 2 and 5), corner cards (figure 3) or cards from adjacent hands (figure 7) or from any other hands (figure 7). Plainly this claim element is disclosed in the specification.

The next two elements of claim 23 are:

“(c) after the exchanges, comparing each of the resulting hands to a payable; and

“(d) paying the player according to amounts set out in the payable for each hand.”

The introduction to the specification (page 1, last sentence before the “Prior Art” Section) states:

“After the exchange, the corner cards could be displayed, and the player paid according to a payoff table.”

These two steps were plainly disclosed in the specification.

Applicant submits that all steps of claim 23 were disclosed and no new matter has been added.

Claim 24

Claim 24 is similar to claims 17 to 19 that were added by pre-examination amendment on October 8, 2002. In the Remarks that accompanies that amendment, Applicant explained that:

“Applicant has added claims to cover two-handed versions of the game. A two-handed embodiment is described in the specification page 2, paragraph 4 where it states:

“In another embodiment the player would have to pay for each hand played. For example, two coins would yield two games, four coins four games, etc. If hands B and D were played they would follow the same logic as described below with respect to hands A and C.”

One way to visualize the embodiments described, is if the player deposited two coins the diamond shape would collapse into two hands that shared common end cards. The three interior cards would initially be unique to each hand, but the player could exchange the cards between hands. These hands would form a pair of hands that could be dealt horizontally, vertically or diagonally. The cards could be dealt so that they appeared to be parallel or they could be dealt so each had an arc that intersected at the end cards.

If one pair of hands were dealt, the player could exchange cards between each hand. In another embodiment, two pairs of hands could be dealt horizontally, each pair shared common end cards and each had three unique interior cards. For example, the first pair could be displayed in the lower portion of a video screen and the second pair of hands displayed on the video screen above the first pair of hands. In this embodiment, the player could exchange cards between each of the four hands.”

This is shown visually below. If two coins were inserted, two hands would be played. Figure A provides a visual illustration of how two hands would collapse into a pair of hands as shown in Figures B or C, and why the claims are supported by the specification. The three interior cards would remain the same and the corner cards would become end cards. In Figure A the top card (card 1) and bottom card (card 8) would combine and become a single card, consistently with the teaching of the

patent to have common cards in a closed figure. The pair of hands could be displayed vertically, as in Figure B or horizontally, as shown in Figure C.

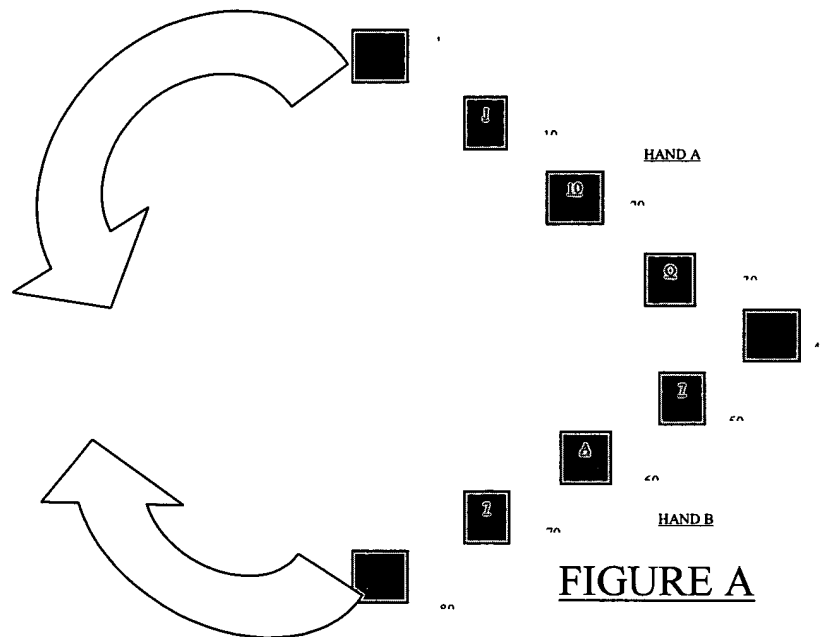


FIGURE A

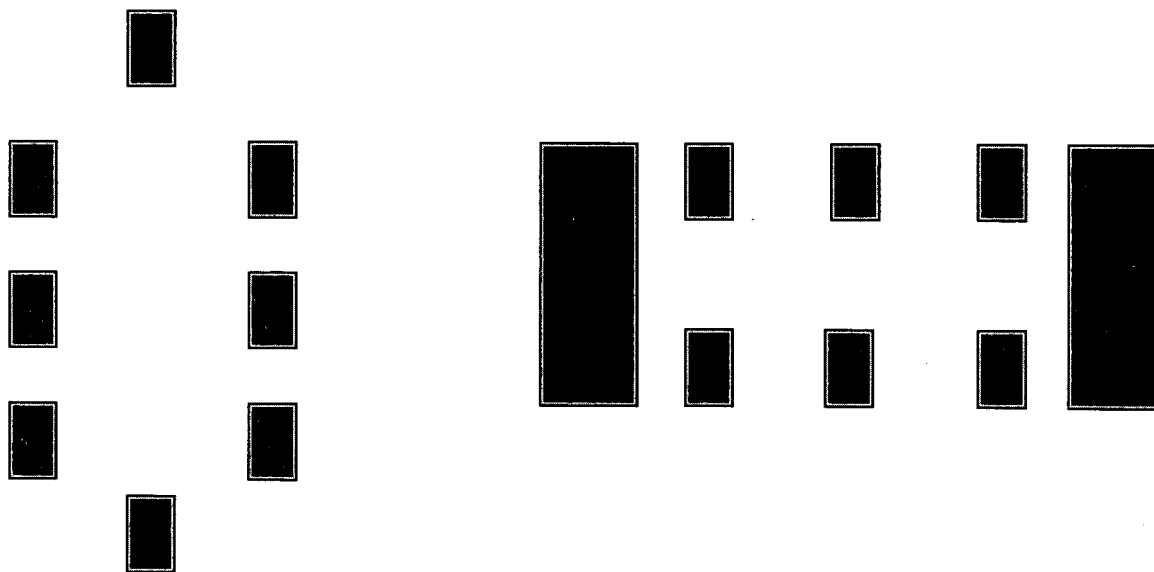


FIGURE B

FIGURE C

Claim 24, a method claim, is a game where pairs of hands have common

end cards:

Serial No. 10/015,314

Art Unit: 3714

Examiner: Rada

A method to play a video poker game that comprises the following steps:

“(a) dealing one or more pairs of hands, each pair of hands has eight cards consisting of three interior cards dealt face up and two end cards dealt face down that are common to each pair of hands”

As explained above, this embodiment exists when two hands are paid for.

“(b) permitting the player to exchange the interior cards between hands”

As explained with regard to claim 23, card exchange is described throughout the specification.

“(c) following the exchanges, revealing the end cards;”

Dealing the corner (end) cards face down is described in Figure 2, and in the introduction to the specification (page 1): “One way to play the game is to deal all three interior cards face up and leave the four corner cards face down ... After the exchange, the corner cards could be displayed, and the player paid according to a payoff table.”

(d) comparing each hand to a payable; and

(e) paying the player according to amounts set out in the payable for each hand.

The two element correspond to element (c) and (d) in claim 23; the supporting disclosure is identified in the discussion of those elements.

The “Paylines”

The Interview Summary of the July 29, 2003 interview, states: “The examiner suggested to the applicant to elaborate on the paylines to define the structure of the diamond shape to further distinguish over the prior art.”

In response to that suggestion, Applicant added the term “each hand forms a separate payable,” or a similar term to all the claims.

In the November 3, 2003 Office Action the examiner stated: "The examiner notes to applicant that the amendments regarding the language of the each side forms a separate payline is considered new matter." Applicant strongly disagrees.

A "payline" is simply a term used in the gaming industry to refer to a group of cards that form a hand on which the player will be paid. Applicant's invention, as disclosed in the initial specification, is a multihand poker game that allows players to play several hands simultaneously. This supports the term "payline." However, to advance prosecution, Applicant has removed the term from the claims.

DOUBLE PATENTING

In Applicant's February 19, 2003 Amendment and Response Applicant agreed to a terminal disclaimer. Applicant was under the impression that a formal terminal disclaimer did not need to be filed until one or the other patents issued. Indeed, Form PTO/SB/26, the PTO's terminal disclaimer form has an entry for a "Patent No." (not an application number). In any case, to expedite prosecution, Applicant has submitted that form, but does not agree that the pending inventions are obvious in view of on another.

OBVIOUSNESS REJECTIONS AND THE PRIOR ART

In the November 3, 2003 Office Action, the examiner stated that Applicant's August 8, 2003 Amendment was not fully response because it had not discussed the prior art. However, during the interview, Applicant and the examiner

discussed that Moody '448 has no applicability to the inventions at issue. Therefore, Applicant believed the obviousness rejections were moot.

In any case, Applicant repeats that the prior art is easily distinguishable from the prior art.

INTRODUCTION

At the outset it is important to establish the framework for an obviousness inquiry. The Examiner is required to consider the four so-called Graham v. John Deere factors:

- “(A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.”

See MPEP § 2141.

In addition, it is critically import to show a motivation to combine references. The MPEP states this requirement as follows:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP § 2142.

"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

MPEP § 2142.

A recent Federal Circuit case, Abbott Laboratories v. Syntrol Bioresearch, Inc. Slip-op. 02-1203 -1257 (Fed. Cir. July 10, 2003), reiterated this important rule:

“Knowledge in the prior art of every element of a patent claim, however, is not of itself sufficient to render claim [sic] obvious.”

As stated in the MPEP, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143.01 citing In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)(emphasis in MPEP).

Finally, the MPEP makes it plain that the combinations the Examiner has made and the conclusion reached are improper:

“Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. ‘The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.’” MPEP 2143.01

Additionally, it is equally important to avoid hindsight analysis, that is where the examiner uses teaching and information in the pending application as a guide to assemble disparate prior art references.

As the Federal Circuit has explained in In re Fritch 972 F.2d 1260, 1266 (1992):

“[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. ... This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’” (Footnotes omitted).

And, in Crown Operations Int’l v. Krone, 289 F.3d 1367, 1376 (Fed. Cir. 2002), the Federal Circuit held (citations omitted):

“‘Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.’”

These ground rules demonstrate Applicant’s invention was not obvious in view of the prior art for at least three key reasons: (1) the differences between the references and the claimed invention are considerable; (2) there is no motivation to combine them; and (3) even if these references were combined, they would not yield Applicant’s invention.

MOODY ‘448

The Moody ‘448 is entirely different from Applicant’s invention. Moody ‘448 is primarily a table game. It does not disclose having a single player play multiple hands, and therefore does not have adjacent hands as that term is used in Applicant’s invention. A fortiori it does not have common cards used in adjacent hands. Rather, Moody is a game where each player must first select from a group of cards presented, which have between two and five cards in each group; the player then creates a five card hand using the cards in the group, and any additional cards if the group has less than five cards. Moody’s Abstract states: “Each player determines which one of the four two-card

groups the player wishes to use.” If the embodiment is one where the player chooses from among two card groups, he is dealt an additional three cards.

Column 6, line 44 to 47 of Moody states:

“Any other suitable layout of the community cards can be used as long as the method of play specifies groups of cards from which each player selects cards to be used.” (Emphases added).

Moody’s disclosure, therefore makes it plain that the players must select from groups of cards presented. The strategy in Moody requires the player to estimate the best possible five-card outcomes from the groups of cards presented. The groups vary from two to five cards with varying numbers of up and down cards.

The examiner erroneously believes these groups of cards are the same as Applicant’s common corner cards. However, Moody’s community cards are not common to adjacent hands. Indeed, in Moody there are no adjacent hands and no player has multiple hands. So the concept of having common corner cards is totally foreign in Moody. Moody may have players sitting next to each other at a card table using the same two- or three-card groups – but that is totally different from Applicant’s invention where a set of 16 cards are dealt in a diamond shape – to a single player – and the corner cards (or ends card in the horizontal embodiment) must be common to the single player’s hands.

This novel approach adds an entirely new strategy to video poker games because the player’s several hands are linked with common cards, and swapping cards can improve one hand while simultaneously making the adjacent had worse. For example, if the player is dealt these two hands as shown below (X are the corner cards; only two of the four hands are shown for illustration):

X -----
 Ace/hearts
 King/hearts HAND A
 Queen/hearts
 X-----
 Queen
 Queen HAND B
 Three/spades
 X -----

Hand A has a potential royal flush, straight and flush. However, if the player exchanges the Queen from Hand A with the Three from Hand B, he will have three of a kind in Hand B, but he will forego the royal flush, straight and flush in Hand A. In the claimed invention, the player must compare the likelihood of all possible payouts of all the potential hands in Hand A (royal flush, flush and straight) to the certain payout for three of a kind. The player, therefore must decide between the possibility of one or more higher payouts in Hand A and the sure payout for three of a kind in Hand B. The payouts are indicated in the specific payable for the game. For one possible payable, the player must decide if he prefers his chance of getting an 800 to 1 payout on the royal flush and leave the cards the way they are, or exchange cards and forego the sure three of a kind payout of 3 to 1 (but keep the 2 to 1 payout for the pair of Queens in Hand B).

Moody does not disclose or suggest this conundrum, and none of the prior art does either. This is another unique element of the Applicant's invention.

Players therefore must consider fairly complex tradeoffs regarding whether the relative improvement of one hand is sufficient to compensate for making another hand worse. Nothing in Moody, or any other prior art suggests this type of decision.

Moreover, in Moody the player must select from two, three, four or five card groups, depending on the embodiment, to complete his hand. By contrast, in Applicant's invention, the player does not have the ability to select any group. He must optimally arrange the cards he is dealt, and does not have the option to select from pre-dealt "groups." This strategy is entirely different from Moody's.

The examiner stated that:

"Moody discloses a poker game having cards (symbols) represented in a four sided diamond shape (column 6, lines 59-63) each side has five cards, three interior cards (player's initial three) and two corner cards (community cards) which are shared with two adjacent hands as recited in claims 1, 10, 17 and 19-20." (May 6, 2003 Office Action, page 4, ¶ 9).

The examiner, however, is incorrect. Figure 2 of Moody shows a configuration of cards in which two-card groups are displayed in the north, south, east and west orientation. If a player were dealt three cards as the examiner has stated and he used the two community cards, he would have a seven-card hand, the two, two-card groups and the "interior cards (player's initial three)." Using Moody's disclosure, there is no way to arrive at five card hand – with cards common in adjacent hands. All Moody's embodiments have at least two-card groups. Thus, even assuming arguendo that Moody's community cards could be considered corner cards (and they are not), simply putting three cards in between them, as the examiner has suggested, will not yield Applicant's invention.

Moreover, Moody does not disclose or suggest swapping, nor could his gaming easily be adapted to have swapping. Moody's game has several players. There is no easy way to have two competing players agree on which cards to swap. Even if Moody were thought to disclose a single player multihand game, there is still no

suggestion or motivation whatsoever to add the swapping feature. Which cards would be swapped? The community cards? The dealt cards? Some combination?

Additionally, because Moody's game requires a player to decide which of several groups of cards to take, it would be very slow to play. Adding a swapping feature (assuming that could somehow be accomplished) would make the game too slow to be useable in a casino setting where speed of play is critical.

WOOD

The examiner cited Wood for the proposition that it teaches "a poker game having the capability of exchanging cards (symbols) from one hand to another hand ..."

(¶ 9). Wood, however, is entirely different from Applicant's novel games.

First, in Wood the player must have a "qualifying hand," which Wood explains is a pair of 7's or better (col. 2, lines 43-46), before the exchange feature is available. Applicant's invention does not require a threshold hand before a player can swap cards. Wood is more like a bonus game. You must have a winning hand before the exchange feature is available. In Applicant's invention, swapping is always available.

In Wood there are no common cards. And there is no teaching in Wood that would allow a person skilled in the art to add common cards to the two separate five-card hand arrangements. It is altogether unclear, without resorting to impermissible hindsight, how one could modify Wood to have common cards.

Moreover, there is no motivation or teaching to convert Wood into a game where cards are arranged in a polygon, where each side is a separate hand.

Again, the strategy in Applicant's invention is entirely different because in Wood all ten cards are visible and the player can exchange cards from one hand to the other. By contrast in Applicant's invention, in claims 2 and 11 for example, only three of five cards are visible in each hand, and there are four interconnected hands displayed. Applicant's invention is far more difficult than Wood because the player does not have all the information about each of the five cards in the hand. These significant differences make Wood a very weak prior art reference.

Additionally, even if Wood and Moody were somehow combined, they would not yield Applicant's invention. How would Wood's two five-card hand games be combined with Moody's group selecting game? How would the cards be dealt? In Moody's pattern or in Wood? Would you pick cards from Moody's group, discard any extra cards, then swap? Or is there some other strategy?

OTHER REFERENCES

The examiner cited Garrod for the proposition that wild cards are well known. Applicant has made no claim that he invented wild cards. It is true they were well known. However, using wild cards in the novel games Applicant has claimed is a unique adaptation of these cards. This rule is set forth in the M.P.E.P.: "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP §2141.02 (emphasis in original). "A prior art reference must be considered in its entirety, i.e., as a whole,

including portions that would lead away from the claimed invention. MPEP 2141.02.
(Emphasis in original).

Garrod does not disclose swapping, common cards or multiple hands as in Applicant's invention. As explained above, because Garrod is basically a series of single hand games, the strategy is entirely different from Applicant's

There is no suggestion in Garrod about how it could be modified to have swapping, and there is no motivation to combine Garrod with Moody or Wood.

Wachtler discloses "buying New cards" (col. 1 lines 5 – 10). Buying new cards is entirely different from paying for the right to swap existing cards. Buying new cards replaces existing cards with the expectation that the unknown new cards will be better. In the extreme case, the player can get an entirely new hand. By contrast, swapping, as explained above, requires the player to rearrange existing cards. The difference is one of attempting to improve a hand by acquisition versus by rearrangement. Furthermore, swapping may improve one hand while making another hand worse. There is no comparable composite result with replacement, either an improved hand or a worse hand. Wachler does not address this issue, and he does not have common cards.

Again, Applicant's invention as a whole must be consider. It is impermissible to compare parts of the invention with snippets of the prior art.

SECTION 112 REJECTIONS

In the November 3, 2003 Office Action, the Examiner stated that the Applicant had not addressed the rejections under paragraphs one and two of section 112.

In the May 6, 2003 Office Action, the Examiner rejected claims 20 to 22 under paragraph one of section 112. Claims 20 to 22 have been deleted, resolving the rejection.

Claims 4 and 15 were rejected under the second paragraph of section 112 as being indefinite because the Examiner stated: “‘the corner cards can be exchanged’ is vague and indefinite because the language noted hereinabove only indicates the possibilities that the corner cards can be exchanged.” Claim 4 has been modified and claim 15 has been deleted.

Additionally, Applicant respectfully submits that the apparatus claims (and all other claims) are fully supported in the specification. The first sentence of the specification states: “This patent relates to an innovative card game that can be played electronically, like video poker ...” Figure 5 shows an electronic gaming apparatus, including a bill or credit card acceptor, a coin slot, a video screen and a player controller. The specification explained that a touch screen or voice commands could be used to swap cards. (See page 3). No more is required to support the apparatus claims or to show that applicant fully possessed the idea of an electronic gaming apparatus and the card games shown when he filed the application.

As stated in the MPEP 2163 II(A)(3)(a) page 2100-165 (emphasis added):

“Possession may also be shown by a clear depiction of the invention in detailed drawings or in structural chemical formulas which permit a person skilled in the art to clearly recognize that applicant had possession of the claimed invention. An adequate written description of the invention may be shown by any description of sufficient, relevant, identifying characteristics so long as a person skilled in the art would recognize that the inventor had possession of the claimed invention.”

Applicant submits that this requirement has fully been met. A person skilled in the art would readily understand that an electronic gaming apparatus was disclosed and would understand that applicant "had possession of the claimed invention." Further, this skilled person would be able to, without undue experimentation, make and use the claimed inventions.

Moreover, electronic apparatus for video poker games have existed for years. Applicant makes no claim that he invented the electronics necessary to carry out the invention. Therefore, the skill required to build the games (which themselves are novel) in an electronic apparatus was well within ability of an ordinary artisan in the field. Therefore no additional disclosure was required. This conclusion is supported by the MPEP which explains MPEP § 2163 page 2100-166:

"What is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met."

The apparatus to play the game was well known. Applicant therefore did not need to disclose every electronic element, chip, memory device, processor, etc. to show the reader: (1) that he had in his possession the claimed invention; and (2) how make and use the invention.

Applicant believes the section 112 rejections have been overcome and that he has addressed all the outstanding issues in the pending Office Actions.